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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,139	12/07/2006	David J. Ross	CAF-35502/03	4935
25/06 7590 06/07/2010 GIFTORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021				
EXAMINER DENTER, CLARK F				
ART UNIT		PAPER NUMBER		
3724				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,139

Applicant(s)

ROSS ET AL.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 5-39 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 40 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on February 12, 2010 has been entered.

Claim Objections

2. Claim 4 is objected to because of the following informalities:

In claim 4, line 2, "the projected cut" is not sufficiently clear and "the" should be changed to --a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 stands rejected under 35 U.S.C. 102(b) as being anticipated by Isaac, pn 2,264,840.

Isaac discloses a device with every structural limitation of the claimed invention including:

a body (e.g., 30 and/or 31); and

a cutting assembly mounted on the body and comprising first and second relatively moveable cutting members (e.g., 11, 12) each defining a cutting edge and an

inner face, the first and second cutting members adapted to permit cooperation between the respective cutting edges to cut by a shearing action along a line of cut while maintaining the inner faces in non-engaging relationship to provide clearance therebetween (e.g., as shown in Figs. 3-6), wherein the first and second cutting members are arranged to pivot relative to each other about a pivot axis (e.g., at 25) which is offset from the line of cut (e.g., the "offset" limitation is fully capable of being performed by the device of Isaac when the device is used in such a manner, such as with the device used at an angle/orientation so that the pivot 25 is raised above the cutting members);

[claim 2] wherein the first and second cutting members of the cutting assembly are arranged such that during a cutting operation the cutting edges are aligned with a projected cutting plane;

[claim 3] wherein the inner face of at least one of the cutting members is inclined outwardly from a projected cutting plane in order to provide clearance between the inner faces when the cutting assembly is operated;

[claim 4] wherein the inner face of each cutting member is outwardly inclined from the projected cutting plane in order to provide clearance between said faces when the cutting assembly is operated;

[claim 42] wherein the pivot axis is located substantially above the line of cut (e.g., when the cutting device of Isaac is used in such an orientation);

[claim 43] wherein the pivot axis is located substantially below the line of cut (e.g., when the cutting device of Isaac is used in such an orientation);

[claim 44] wherein the location of the pivot axis permits the transport of material under the pivot axis, without the pivot axis passing through the material (e.g., when the cutting device of Isaac is used in such an orientation);

[claim 45] further comprising a support member (e.g., 27; or 28) wherein the first cutting member (e.g., 11; or 12) is rigidly mounted on the support member and the second cutting member (e.g., 12; or 11) is pivotally mounted on the support member.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Isaac, pn 2,264,840.

Isaac discloses a device with almost every step of the claimed method including: providing a cast cutter including:

a body (e.g., 30, 31);

a cutting assembly mounted on the body and comprising first and second relatively moveable cutting members (e.g., 11, 12) each defining a cutting edge and an inner face, the first and second cutting members adapted to permit cooperation between the respective cutting edges to cut by a shearing action along a line of cut while maintaining the inner faces in non-engaging relationship to provide clearance therebetween (e.g., as shown in Figs. 3-6), wherein the first and second cutting members are arranged to pivot relative to each other about a pivot axis which is offset from the line of cut (e.g., the "offset" limitation is fully capable of being performed by the device of Isaac when the device is used in such a manner, such as with the device used at an angle/orientation so that the pivot 25 is raised above the cutting members).

Isaac lacks the application of the device to cut a cast including the steps of: manipulating the cast-cutter to position a cast material to be removed from a patient between the first and second cutting members; and

activating the cast-cutter to cause relative movement of the first and second cutting members to cause the cast material to be cut by cooperation of the cutting edges.

However, the Examiner takes Official notice that using shears to cut a cast is old and well known in the art and that shears in general are used to cut the material of a cast to remove the case or undesired portions of the cast. Numerous examples of such a use are widely known. Further, the use of the particular type of shears disclosed by Isaac, namely tin snips, would have been when facing the problem of cutting a cast with only those shears available. Therefore, it would have been obvious to one having ordinary skill in the art to perform the method of cutting a cast with the shears of Isaac for well known reasons including those discussed above.

Response to Arguments

7. Applicant's arguments filed February 12, 2010 have been fully considered but they are not persuasive.

In the first and second full paragraph on page 12 of the subject response, applicant argues that the prior art device to Isaac does not teach or suggest the particular orientation of the pivot with respect to the cutting members; specifically, that the pivot is offset from a line of cut of the cutting members. The Examiner respectfully disagrees with applicant's analysis. It is respectfully submitted that the prior art cutting device to Isaac is fully capable of being used in such an offset orientation by simply reorienting the cutting device of Isaac during use thereof. Because this reorientation or repositioning does not involve any structural modification of Isaac's device, such a limitation must be considered to be a functional recitation of intended use. And, as applicant is well aware, such a functional recitation of intended use, wherein such a

functional recitation does not clearly imply any additional structure, cannot be relied upon to distinguish a claimed invention over the prior art.

Further, as described in the prior art rejections above, Isaac meets the amended claims with respect to the positive recitation that the cutting members are "mounted" to the body in that the cutting members are disclosed as being mounted to members 30 and/or 31 which can be considered to be "a body."

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-

4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cf
June 3, 2010